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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,456	09/25/2003	Jyh-Ching Yaur	2003P02690 US01	5513

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Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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AN, IG TAI

ART UNIT	PAPER NUMBER
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3687

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03/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,456	<b>Applicant(s)</b> YAU, JYH-CHING	
	<b>Examiner</b> IG TAI AN	<b>Art Unit</b> 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/25/2003</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This communication is a First Office Action Non- Final Rejection on the merits.

Claims 1 - 20 are currently pending and have been considered below.

#### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Healthcare Tax Deductible Expenses Tracking and Record Keeping System and Method.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**4. Claims 1 – 2, 4, 7 - 8, and 10 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu (US 5748908) in view of Chong (US 5335169).**

**As per Claim 1**, Yu teaches a system for creating records identifying items supporting tax determination (Abstract teaches creating records of classifying items for tax determination), comprising:

an input processor for receiving information identifying a service provided to a specific entity and to be at least partially paid for by said specific entity (Abstract teaches system receives cardholder name (specific entity), transaction amount, and vendor identification);

a data processor for automatically, identifying a type of said service identified in said received information (Abstract teaches that the system automatically classifies the expenditure by categories);

an output processor for processing said data representing said record for output in response to user command (Abstract, Figure 9 and Figure 10 teach a report, which has processed information of entity information, classified service and the expenses, is created and remitted to user at any time).

However, Yu is silent regarding, allocating a predetermined tax related identification code to said service based on service type and incorporating said allocated code, together with information identifying said service in data representing a record.

Chong discloses system for tracking multiple rate assessments on transactions allocating a predetermined tax related identification code to said service based on service type and incorporating said allocated code, together with information identifying said service in data representing a record (Appendix A, G, and Column 2 line 23 – 66 teaches assigning tax codes for different services or product based on tax types).

Therefore, from this teaching of Chong, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify automated classified expenditure data card recording system of Yu to include assigning tax code for service or product as taught by Chong to accelerate the tax preparation or return process.

**As per Claim 2**, Yu discloses said data processor automatically identifies said type of said service from different types of services subject to potentially different taxation treatment and provided to said specific entity, said different types of services including at least one of, (a) medical services, (b) dental services, (c) education services and (d) dependent care expenses (Figure 9 teaches medical service, education services and childcare services provided to the specific entity (account holder)).

**As per Claim 4**, Yu teaches wherein said input processor receives information identifying a plurality of services provided to a specific entity by multiple different organizations, said data processor, identifies said type of said services identified in said

received information (Figure 7 teaches different organization providing services to the specific entity)

However, Yu is silent regarding allocates predetermined tax related identification codes to said services based on service type and incorporates said allocated codes, together with said information identifying said services, in data representing said record.

Chong discloses system for tracking multiple rate assessments on transactions allocates predetermined tax related identification codes to said services based on service type and incorporates said allocated codes, together with said information identifying said services, in data representing said record (Appendix A, G, and Column 2 line 23 – 66 teach the tax code is assigned to the product or service and transactions report).

Therefore, from this teaching of Chong, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify automated classified expenditure data card recording system of Yu to include assigning tax code for service or product as taught by Chong to accelerate the tax preparation or return process.

**As per Claim 7**, Yu discloses wherein said system is employed in processing expenditure records associated with at least one of, (a) a credit card and (b) a debit card, and said record for output comprises a statement to said specific entity (Abstract and Figure 9).

**As per Claim 8**, Yu teaches all the elements of the claimed invention, but is silent regarding said data processor incorporates said allocated code in said data representing said record without manual intervention and said code identifies said service from different types of services subject to potentially different taxation treatment and provided to said specific entity (Appendix B, C, and G).

**As per Claim 10**, Yu teaches wherein said specific entity comprises at least one of (a) a patient, (b) a healthcare provider organization, (c) an individual person and (d) a group of physicians (Column 12 – 13 teaches the account holder (patient) and vendor (service provider)), but is silent regarding wherein said data processor automatically searches for information identifying other services also provided to said specific entity and incorporates data identifying said other services together with associated allocated tax related identification codes in said record.

Chong discloses wherein said data processor automatically searches for information identifying other services also provided to said specific entity and incorporates data identifying said other services together with associated allocated tax related identification codes in said record (Appendix A, G, and Column 2 line 23 – 66).

Therefore, from this teaching of Chong, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify automated classified expenditure data card recording system of Yu to include assigning tax code for service or product as taught by Chong to accelerate the tax preparation or return process.

**As per Claim 11**, Yu discloses wherein said data processor periodically collates data identifying said other services together and processes said record for output in at least one form selected from (a) electronic form, (b) a printed report form and (c) a file suitable for communication via the internet (Column 14 line 65 – column 15 line 50 teaches the periodically sending statement to the customer).

However, Yu is silent regarding associated allocated tax related identification codes in said record. Chong discloses associated allocated tax related identification codes in said record (Appendix G).

Therefore, from this teaching of Chong, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify automated classified expenditure data card recording system of Yu to include assigning tax code for service or product as taught by Chong to accelerate the tax preparation or return process.

**As per Claim 12**, Yu disclose wherein said data processor accumulates information identifying payments made by said specific entity and information identifying services associated with said payments (Figure 9).

**5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in View of Chong as applied to claim 1 above, and further in view of Hausdorff (US 4192006).**



**As per Claim 3**, Yu and Chong's combination discloses all the elements of the claimed invention but is silent regarding mileage information

Hausdorff discloses a portable travel expense tabulator having receives mileage information (Abstract teaches mileage expense information).

Therefore, from this teaching of Hausdorff, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify expense tracking system which identify service and product and allocate a proper tax code for service and product of Yu and Chong's combination to include mileage information as taught by Hausdorff to utilize mileage information for the tax preparation or tax return.

**6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Chong as applied to claim 1 above, and further in view of Humberto Cruz (Milwaukee Journal Sentinel).**

**As per Claim 5**, Yu can Chong's combination teaches all the elements of the claimed invention but is silent regarding a plurality of people associated with said specific person.

Humberto discloses a tax return method including a plurality of people associated with said specific person (Humberto Cruz discloses him and his wife is bunching the expenses to get more tax reduction).

Therefore, from this teaching of Humberto Cruz, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify expense tracking system which identify service and product and allocate a proper tax code for service and product of Yu and Chong's combination to include a plurality of people associated with a specific person as taught by Humberto Cruz to receive more tax return.

**As per Claim 6** Yu can Chong's combination teaches all the elements of the claimed invention but is silent regarding said plurality of people are related to said specific person and said services provided to said plurality of people potentially affect tax payable by said specific person.

Humberto Cruz discloses a tax return method having said plurality of people are related to said specific person and said services provided to said plurality of people potentially affect tax payable by said specific person (Humberto Cruz discloses him and his wife is bunching the expenses to get more tax reduction).

Therefore, from this teaching of Humberto Cruz, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify expense tracking system which identify service and product and allocate a proper tax code for service and product of Yu and Chong's combination to include a plurality of people associated with a specific person as taught by Humberto Cruz to receive more tax return.

**7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Chong as applied to claims 1 and 8 above, and further in view of Nina Kim (The Post Standard).**

**As per Claim 9**, Yu and Chong's combination teaches all the elements of the claimed invention but is silent regarding said different types of services comprise an outpatient service and an inpatient service.

Nina Kim discloses said different types of services comprise an outpatient service and an inpatient service (Abstract).

Therefore, from this teaching of Nina Kim, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify expense tracking system which identify service and product and allocate a proper tax code for service and product of Yu and Chong's combination to include inpatient and outpatient service as taught by Nana Kim to Maximize the tax return amount.

**Claims 13 – 15 and 18 – 20 have same or similar limitations to Claim 1 – 12. Therefore, Claims 13 – 15 and 18 – 20 are rejected under same rationale.**

**8. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Chong and in further view of Hinderer (US 20040153396).**

**As per Claim 16**, Yu and Chong's combination discloses all the elements of the claimed invention but is silent regarding determines if said new cumulative total exceeds a predetermined threshold.

Hinderer discloses a telecommunication credit communication system which determines if said new cumulative total exceeds a predetermined threshold (Figure 6 and paragraph 46 teaches that the system checks if the spending is over the limit).

Therefore, from this teaching of Hinderer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify expense tracking system which identify service and product and allocate a proper tax code for service and product of Yu and Chong's combination to include a function that determines the if the total spending is over the threshold or limit as taught by Hinderer to prevent the customer from spending more than allowed credits.

**As per Claim 17**, Yu and Chong's combination discloses all the elements of the claimed invention but is silent regarding said data processor includes in said data representing said record information indicating that said new cumulative total exceeds said predetermined threshold.

Hinderer discloses a telecommunication credit communication system having said data processor includes in said data representing said record information indicating that said new cumulative total exceeds said predetermined threshold (Figure 6 and paragraph 46 teaches that the system that send reports regarding excessive total).

Therefore, from this teaching of Hinderer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify expense tracking system which identify service and product and allocate a proper tax code for service and product of Yu and Chong's combination to include a function that records information indicating that the total spending is over the threshold or limit as taught by Hinderer to prevent the customer from spending more than allowed credits.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kunkler (US 6014454) discloses expenditure tracking check.

Kennedy (US 20020178039) discloses accelerated tax reduction platform.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IG TAI AN whose telephone number is (571)270-5110. The examiner can normally be reached on Monday - Thursday from 9:30 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3687

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/  
Supervisory Patent Examiner, Art  
Unit 3687

ITA